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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 1545)

In re Application of:	
Moll, et al.	
	Group Art Unit 2617
Serial No.: 09/826,139	
	Examiner: Un C. Cho
Filed: April 4, 2001	
	Confirmation No. 2337
For: Method and System For Providing Location Based Information To A Mobile Station	

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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   b. Return Receipt Postcard.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

(Attorney Docket No. 1545)

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REPLY BRIEF

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I. Introduction

The Examiner's Answer mailed May 18, 2006 failed to rebut the points of clear error identified in Applicant's Appeal Brief. This Reply Brief addresses the specific arguments made in the Examiner's Answer.

II. Argument

A. The Examiner Erred in Rejecting Claims 2, 4, 6, 7, 10, and 11 as Being Obvious over a Combination of Moore and Papadimitriou

In Section VII.A of the Appeal Brief, Applicant demonstrated that the Examiner's reliance on Papadimitriou to make up for the deficiencies in Moore was clear error because (i) the Examiner's argument is internally inconsistent and (ii) Papadimitriou actually teaches away from including a service identifier that determines the level of granularity ***in*** the request for location based information.

Although the Examiner's Answer tries to resolve issue (i), the Examiner's explanation actually reinforces the fact that the Examiner's argument is internally inconsistent. In particular, the Examiner's explanation shows that the Examiner is improperly relying on ***two different*** location requests in Papadimitriou: the location request received from the user (step 215 in Fig. 2) and the GMLC location estimate request generated in the network (step 235 in Fig. 2).

With respect to issue (ii), the Examiner's Answer simply ignores Papadimitriou's description of how the user is prompted to enter the priority level that determines the precision for locating the mobile station ***after*** receiving the user's location request. By failing to address this "prompt for priority" teaching in Papadimitriou, the Examiner has failed to follow the rule that "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions

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that would lead away from the claimed invention." MPEP § 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.3d 1540, 220 USPQ 303 (Fed. Cir. 1983).

These two aspects of the Examiner's clear error are discussed separately below.

1. The Examiner's Argument Is *Still* Internally Inconsistent

In Section VII.A.1 of the Appeal Brief, Applicant explained how the Examiner's argument for using Papadimitriou to reject claim 4 was internally inconsistent (the same inconsistency permeates the Examiner's rejections of the other claims). To try to explain away the inconsistency, the Examiner's Answer argues (on page 17) that it is only the "location request" in Papadimitriou that is being used as the "service identifier" in the Examiner's claim rejections. However, this "explanation" is still internally inconsistent because it relies on ***two different*** location requests.

In particular, the explanation in the Examiner's Answer (page 17) cites to two sections of Papadimitriou, col. 5, lines 56-64 and col. 6, lines 41-48. The first section, col. 5, lines 56-64, describes a location request that is received from the user (step 215 in Fig. 2). The second section, col. 6, lines 41-48, describes a "GMLC location estimate request" (step 235 in Fig. 2). The GMLC location estimate is generated by the Gateway Mobile Location Center (GMLC) ***after*** receiving the location request from the user (col. 6, lines 23-29). More particularly, as described in col. 6, lines 3-12, the GMLC location estimate request (step 235) is generated ***after*** the user is prompted for priority (step 220). This sequence of steps is illustrated in Papadimitriou's Figure 2, which is reproduced below:

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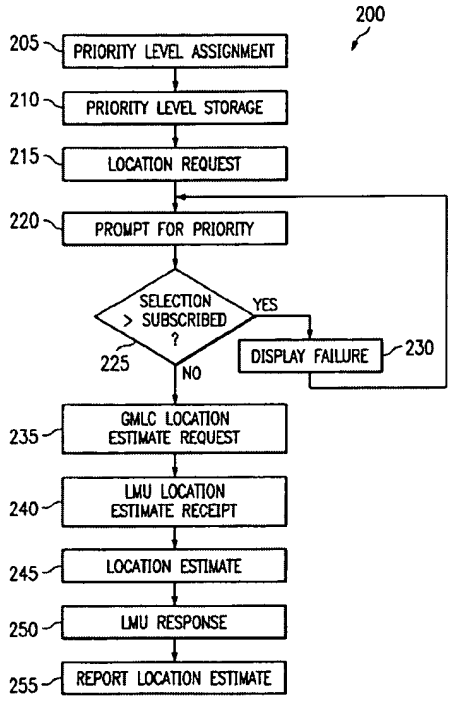

FIG. 2

The location requests in steps 215 and 235 are separate and distinct, but the Examiner's Answer lumps them together and treats them as if they were the same. Thus, the inconsistency in the Examiner's argument remains.

The reason why the Examiner lumps these two separate and distinct location requests together is that neither location request by itself fits the requirements of claim 4. In particular, as discussed below, the Examiner is attempting to rely on some of the qualities of the location request in step 215 and some of the qualities of the GMLC location estimate request in step 235. In so doing, the Examiner has created a hindsight-inspired "location request" that is simply not taught in the prior art.

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Step 215 is the necessary starting point for the Examiner because Papadimitriou is used to fill in the gaps left by Moore. In the Examiner's rationale, the "request for location based information regarding a service" recited in claim 4 is met in Moore by the "message comprising a request for the local information and services" that the mobile station transmits to the wireless network (Moore, col. 3, lines 10-18). A profile with a set of custom categories used to generate local information and services can be sent with the message (Moore, col. 5, lines 6-11). Thus, the Examiner argues that the "request" in Moore includes "a service identifier" (i.e., the profile), "wherein the service identifier is associated with the service," as recited in claim 4. However, Moore does not teach the "level of granularity" recited in claim 4. For that element, the Examiner relies on Papadimitriou.

The Examiner relies on the location request of step 215 in Papadimitriou, because, as in Moore, it is a request transmitted by the mobile device to the network. Thus, in the Examiner's postulated Moore/Papadimitriou combination, the location request of step 215 would include the profile in Moore that the Examiner identifies as the "service identifier." However, the location request of step 215 does ***not*** have the priority level from which the location precision is determined. This is because the priority level is determined later, after the user is prompted for priority in step 220, as described in col. 5, line 66 – col. 6, line 7.[1] Because the location request of step 215 still does not make up for the deficiencies in Moore, the Examiner also relies on the GMLC location estimate request of step 235.

[1] Papadimitriou also notes that a call to an emergency number (E-911) is treated as a highest priority request and location request step 215 proceeds by emergency services path 217 to GMLC location estimate request step 235 (col. 5, lines 58-63). This is a special case that is not relevant to claim 4. An E-911 call is not a "request for location based ***information*** regarding a service."

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In particular, the GMLC location estimate request of step 235 includes the priority information that determines the level of precision of the location estimate (col. 6, lines 41-45). However, the GMLC location estimate request of step 235 is generated by the network (col. 6, lines 23-29), not transmitted by the mobile device. Thus, the GMLC location estimate request of step 235 does not correspond to the request in Moore and would not include the profile in Moore that the Examiner identifies as the "service identifier." Moreover, the GMLC location estimate request of step 235 is not "a request for location based information regarding a service," as recited in claim 4. The GMLC location estimate request of step 235 does not request information regarding a service; rather, it invokes the Location Measurement Units (LMUs) in the network to estimate the location of the mobile device (col. 6, lines 41-56; steps 240-255 in Fig. 2).

Thus, the Examiner's rejection of claim 4 is internally inconsistent because the Examiner's rationale relies on the location request of step 215 in order to correspond to Moore's request for local information and services but then switches to the GMLC location estimate request of step 235 in order to show a priority level that determines the precision of the location estimate. While improper in and of itself, the Examiner's lumping together of two separate and distinct location requests also leads to another fatal flaw in the Examiner's claim rejections. As discussed below, the Examiner glosses over the fact that Papadimitriou teaches away from claim 4 by teaching a "prompt for priority" step.

2. Papadimitriou teaches away from including the service identifier that determines the level of granularity *in* the request for location based information

The Examiner's Answer argues (on pages 17-18) that Papadimitriou teaches including the service identifier that determines the level of granularity ***in*** the request for location based

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information because the priority information is generated in the GMLC location estimate request of step 235. The flaw in this argument is that the GMLC location estimate request of step 235 is not "a request for location based information regarding a service," as recited in claim 4. Instead, step 235 invokes the Location Measurement Units (LMUs) in the network to estimate the location of the mobile device (col. 6, lines 41-56; steps 240-255 in Fig. 2). The LMUs do not obtain location information regarding a service, they simply estimate the locations of the mobile devices.

Moreover, the Examiner's argument also glosses over the fact that the priority information is obtained by prompting the user in "prompt for priority" step 220 (col. 5, line 66 – col. 6, line 2). This "prompt for priority" step is crucial because Papadimitriou's method proceeds to the GMLC location estimate request of step 235 only if the user selects a desired priority level that is lower than or equal to the subscribed priority level (col. 6, lines 3-12). If the user selects a desired priority level that is higher than the subscribed priority level, a display failure step is reached (col. 6, lines 12-22).

By teaching that the user is prompted for a prior level that determines the level of precision for locating the mobile station ***after*** the user has sent the location request, Papadimitriou teaches away from the claimed approach in which the request for location based information already ***includes*** the service identifier that determines the level of precision for locating the mobile station. By failing to consider this teaching away in Papadimitriou, the Examiner has failed to consider Papadimitriou as a whole. *See* MPEP § 2141.02(VI); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.3d 1540, 220 USPQ 303 (Fed. Cir. 1983).

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B. The Examiner Erred in Rejecting Claim 3 as Being Obvious Over a Combination of Moore, Papadimitriou and Caughran

Claim 3 depends from claim 4. As discussed above, the combination of Moore and Papadimitriou fails to teach or suggest all of the limitations of claim 4. Caughran does not make up for the deficiencies in the Moore/Papadimitriou combination. Thus, the Examiner's rejection of claim 3 is improper for at least the same reasons that the Examiner's rejection of claim 4 is improper.

C. The Examiner Erred in Rejecting Claim 5 as Being Obvious Over a Combination of Moore, Papadimitriou and Alperovich

Claim 5 depends from claim 4. As discussed above, the combination of Moore and Papadimitriou fails to teach or suggest all of the limitations of claim 4. Alperovich does not make up for the deficiencies in the Moore/Papadimitriou combination. Thus, the Examiner's rejection of claim 5 is improper for at least the same reasons that the Examiner's rejection of claim 4 is improper.

D. The Examiner Erred in Rejecting Claims 8 and 15 as Being Obvious Over a Combination of Moore, Papadimitriou and Chern

Claims 8 and 15 depend from claim 4. As discussed above, the combination of Moore and Papadimitriou fails to teach or suggest all of the limitations of claim 4. Thus, the Examiner's rejections of claims 8 and 15 are improper for at least the same reasons that the Examiner's rejection of claim 4 is improper.

E. The Examiner Erred in Rejecting Claim 9 as Being Obvious Over a Combination of Moore, Papadimitriou, Chern and Richton

Claim 9, like claim 4, recites "receiving a request for location based information regarding a service, the request including a service identifier, wherein the service identifier is

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associated with the service; associating a level of granularity with the service identifier; based on the service identifier, instructing the cellular wireless system to determine the position of the mobile station at the associated level of granularity." Thus, the Moore/Papadimitriou combination fails to teach these elements in claim 9 for the same reasons that the combination fails to teach these same elements in claim 4. Chern and Richton do not make up for the deficiencies in the Moore/Papadimitriou combination. Thus, the Examiner's rejection of claim 9 is improper for at least the same reasons that the Examiner's rejection of claim 4 is improper.

F. The Examiner Erred in Rejecting Claim 12 as Being Obvious Over a Combination of Richton and Papadimitriou

Claim 12 recites, *inter alia*, "a switch" and a computer that runs a program that performs the step of "receiving from the ***switch*** a request for location based information regarding a service, wherein the request includes a service identifier, and wherein the service identifier is associated with the service."

The Examiner's Answer argues (on page 19) that Richton teaches a wireless switching center (WSC) 220 that is capable of (1) providing wireless communications service to wireless mobile unit, (2) monitoring the movement of wireless mobile unit as it remotely travels; and (3) providing location based information back to the wireless mobile unit based on the observed changing location of the wireless mobile unit. In fact, Richton states that these are capabilities of a "system" that includes WSC 220 ***and*** a location based-server 221 (col. 2, lines 59-65). Moreover, Richton states explicitly that it is the location based-server 221, not WSC 220, that is responsible for providing location-based information services:

> The location-based server 221 is responsible for providing all location-based information services for wireless mobile unit 201.

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(col. 3, lines 6-8). Thus, the argument regarding Richton in the Examiner's Answer is clearly wrong. Moreover, even if the Examiner's argument regarding WSC 220 in Richton were correct, it still does not show a request for location based information regarding a service that is ***received from the switch***, nor does it show a service identifier that is associated with the service. Accordingly, Richton does not teach or suggest the "receiving" step of claim 12.

Papadimitriou does not make up for this deficiency in Richton. As noted above in Section VII.A.2, Papadimitriou actually teaches away from a request for location based information regarding a service that ***includes*** a service identifier associated with the service. Because the Richton/Papadimitriou combination does not teach each and every element of claim 12, the Examiner has failed to make a *prima facie* case of obviousness of claim 12. Accordingly, Applicant respectfully submits that the Examiner's rejection of claim 12 is improper and should be reversed.

G. The Examiner Erred in Rejecting Claims 13 and 14 as Being Obvious Over a Combination of Richton, Papadimitriou, Caughran and Chern

Of these claims, claim 13 is independent and claim 14 is dependent therefrom. Claim 13 recites, *inter alia*, the step of "receiving a request for location based information regarding a service, the request including a service identifier, wherein the service identifier is associated with the service." To try to show this element in Richton, the Examiner's Answer (on page 20) argues that "the mobile unit does make a request, wherein the request having instruction information in association with the telephone number which indicates information to be output to the wireless mobile unit, and the request is received at the location based server through the WSC and the result is sent back to the wireless mobile unit through the WSC," citing to col. 3, lines 15-28 and 39-66. In fact, this section of Richton does not mention any request from the mobile unit

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whatsoever. The "instruction information" is ***not*** in a request from the mobile unit, as the Examiner has alleged; rather, the "instruction information" is stored in a memory in location-based service database 302 (col. 3, lines 12-15).

Moreover, the section cited by the Examiner actually teaches sending location-based information to the mobile unit ***automatically*** when the mobile unit reaches a certain geographic relationship with a target, not in response to a request from the mobile unit. For example, based on the mobile unit's geographic triggering preferences, the location server might send airline scheduling information to the mobile unit when the mobile unit comes within 2 miles of the airport (col. 3, lines 52-60). This automatic process is further illustrated in Figure 4 of Richton (col. 7, lines 12-29). At step 406, it is determined whether the mobile unit "has satisfied the preset geographic relationship with the target location" (col. 10, line 65 – col. 11, line 3). If the mobile unit has satisfied the criteria, then the information is retrieved in step 408 (col. 11, lines 56-57) and is sent to the mobile unit in step 410 (col. 12, lines 1-2). Because this process happens automatically, i.e., when the mobile unit satisfies a predetermined geographic relationship with a target, there is no need in Richton for the mobile unit to send a request for location based information regarding a service.

Accordingly, Richton does not teach or suggest the "receiving" step of claims 13 and 14. The other references in the Examiner's combination, Papadimitriou, Caughran, and Chern, do not make up for this deficiency in Richton. Indeed, as noted above in Section VII.A.2, Papadimitriou actually teaches away from a request for location based information regarding a service that ***includes*** a service identifier associated with the service. Because the combination of Richton, Papadimitriou, Caughran, and Chern do not teach each and every element of claims 13 and 14,

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the Examiner has failed to make a *prima facie* case of obviousness of these claims. Accordingly, Applicant respectfully submits that the Examiner's rejections of claims 13 and 14 are improper and should be reversed.

III. Conclusion

Applicant has demonstrated that the rejections of claims 2-15 are in error as a matter of law. Applicant therefore requests reversal of the rejections and allowance of all pending claims in this application.

Respectfully submitted,

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